

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
June 17, 1998

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re International Coffee & Tea, Inc.

Serial No. 74/475,672

Roger H. Stein and Monique A. Morneault of Wallenstein & Wagner for applicant.

Angela Bishop Wilson, Trademark Examining Attorney, Law Office 101 (R. Ellsworth Williams, Managing Attorney).

Before Hanak, Quinn and Walters, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by International Coffee & Tea, Inc. to register the mark THE COFFEE BEAN ("COFFEE" disclaimed) for "coffee beans, ground coffee, loose tea, tea bags, hot chocolate, chocolate-based food beverages and pastries" (in International Class 30), and "retail shops and mail order services featuring coffee, chocolate and tea-based beverages, coffee beans, ground coffee, chocolate products, loose tea and tea bags, pastries, coffee and tea

related products, namely, cups, mugs and filters and clothing, namely, t-shirts; and office coffee supply services" (in International Class 42).¹ Applicant claimed acquired distinctiveness under Section 2(f) of the Trademark Act; the Examining Attorney accepted applicant's evidence of acquired distinctiveness.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Act on the ground that applicant's mark, when used in connection with applicant's goods and services, so resembles the previously registered marks



for "coffee, tea, herbs and spices"² and THE COFFEE BEANERY, LTD. for "coffee, tea, processed herbs, and spices,"³ both registrations owned by the same entity, as to be likely to cause confusion.

¹ Application Serial No. 74/475,672, filed December 29, 1993, alleging first use anywhere and first use in commerce in 1968.

² Registration No. 1,187,008, issued January 19, 1982; renewed. The word "Coffee" is disclaimed.

³ Registration No. 1,610,706, issued August 21, 1990; renewed. The registration includes disclaimers of "Coffee" and "Ltd."

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs, and both appeared at an oral hearing.⁴

Applicant argues, in urging that the refusal be reversed, that applicant's mark is different in sound, appearance and commercial impression from the registered marks. Applicant asserts that the Examining Attorney, in comparing the marks, improperly dissected them, thereby ignoring the well settled principle that marks must be considered in their entirety in analyzing likelihood of confusion. Applicant also points to the differences in meanings between a "bean" which is an "edible nutritious seed of various species of leguminous plants," and "beanery" which is a "cheap, usually inferior restaurant." Applicant does not dispute that its application and the cited registrations overlap to the extent that the identifications include coffee and tea, but goes on to contend that the mere presence of the term "coffee" in the marks does not result in a likelihood of confusion. In this connection, applicant points to the presence of the word "coffee" in several of the third-registrations

⁴ As noted above, the oral hearing was held almost five years ago. The delay in deciding this case was occasioned by repeated suspensions of the appeal since the hearing to allow applicant time to obtain registrant's consent to the registration sought herein. The attempt ultimately was unsuccessful.

submitted by the Examining Attorney. Applicant also asserts that coffee purchasers have become sophisticated,⁵ and points to the absence of any actual confusion between the marks despite over twenty years of contemporaneous use. Applicant submitted dictionary definitions of the words "bean" and "beanery."

The Examining Attorney maintains that the goods are, in part, identical, and that applicant's services are related to registrant's goods inasmuch as the services feature coffee, tea and related items. As to the marks, the Examining Attorney contends that they are substantially similar, having only minor distinctions. Purchasers would believe, the Examining Attorney argues, that registrant has merely adopted a variation of its marks and expanded its trade channels to include retail and mail order services. The Examining Attorney also is not convinced that coffee consumers are sophisticated, and is not persuaded by the lack of actual confusion. The Examining Attorney submitted third-party registrations showing that others have adopted the same mark for the types of goods and/or services involved herein.

⁵ In support of this contention, applicant submitted "Exhibit A" with its brief, and requested that the Board take judicial notice of it. Simply put, the printout from an electronic database is not proper subject matter for judicial notice. Accordingly, this evidence has not been considered in reaching our decision.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion. In re E.I. du Pont de Nemours and Co., 476 F.2d 1098, 192 USPQ 24 (CCPA 1976). Not all of the du Pont factors may be relevant or of equal weight in a given case, and "any one of the factors may control a particular case." In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003), citing In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

Turning first to compare applicant's goods and services with registrant's goods, the involved application and cited registrations all list coffee and tea. Thus, there is no disputing the fact that the goods, at least in part, are identical. Further, the remaining goods are substantially similar to each other. In addition, applicant's services feature, among other things, coffee and tea and, thus, we find applicant's services to be closely related to registrant's goods.

The goods and services involve the same channels of trade and would be purchased by the same classes of purchasers. The goods and services are relatively inexpensive, and would be the subject of impulse purchases.

In view thereof, the du Pont factors relating to the goods and services weigh in favor of a finding of likelihood of confusion.

That brings us to a consideration of the involved marks. The dictionary definitions of record show "bean" defined as "the edible nutritious seed of various species of leguminous plants; any of various other beanlike seeds or plants, as the coffee bean," and "beanery" defined as a slang term meaning "a cheap, usually inferior, restaurant." There is no question but that the word marks THE COFFEE BEAN and THE COFFEE BEANERY LTD. share similarities in sound and appearance. The marks, however, are different in terms of meaning. While the overall commercial impression engendered by applicant's mark is obvious, registrant's mark conveys a somewhat different idea, that is, that registrant's coffee emanates from a corporate enterprise or restaurant. This difference in meaning, coupled with the clearly limited scope of protection of registrant's marks, plays a significant role in our analysis.

The only common feature shared by the marks is the highly descriptive (if not generic) root term "coffee bean."⁶ We conclude that the mere presence of this common,

⁶ In saying this, we reiterate the difference in meaning between the words "bean" and "beanery."

highly descriptive or generic portion in the marks is insufficient here to support a finding of likelihood of confusion, even though the marks are used in connection with the same goods. See: In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); and Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976). Also, the addition of a design element in registrant's logo mark serves to further distinguish this cited mark from applicant's mark.

Turning our attention to another du Pont factor, applicant claims that there has been no actual confusion between applicant's mark and registrant's marks despite over twenty years of contemporaneous use.⁷ Although the record includes a few details about applicant's use of its

⁷ In this connection, applicant has made reference to a declaration of applicant's president, Ms. Hyman, which was submitted in connection with the prosecution of applicant's companion application Serial No. 74/474,894. Ms. Hyman apparently attested to the effect that applicant is neither aware of, nor has it encountered, any incidents of actual confusion with registrant's mark. Applicant's prior application matured into Registration No. 2,164,914, pursuant to Section 2(f), on June 16, 1998. The registered mark is THE COFFEE BEAN & TEA LEAF with pictorial representations of a coffee bean and a tea leaf for goods and services essentially identical to the ones listed in the present application. In the registration, applicant claims ownership of Registration No. 994,791 for a pictorial representation of a coffee bean and a design (the representation of the coffee bean disclaimed). No oppositions were filed against registration of those marks. The problem with according any probative value to Ms. Hyman's statement is that no such verified statement was properly made of record in the present application, and each case must stand on its own evidence. Moreover, the present application is for a different mark.

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mark, the record is silent as to the extent of registrant's use. Thus, we are at a significant disadvantage to ascertain, with any degree of accuracy, whether there have been opportunities for confusion to have occurred. Accordingly, this factor has not entered into our analysis.

Decision: The refusals to register are reversed.